



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/140,886	08/26/1998	HERBERT M. WILSON	N1205-003	9239

32905 7590 03/14/2005

JONDLE & ASSOCIATES P.C.
9085 EAST MINERAL CIRCLE
SUITE 200
CENTENNIAL, CO 80112

EXAMINER

FOX, DAVID T

ART UNIT	PAPER NUMBER
----------	--------------

1638

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/140,886

Applicant(s)

WILSON ET AL.

Examiner

David T. Fox

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 2/22/04 & 2/23/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-22.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

Item 3. AMENDMENTS

a) New issues: 112 second paragraph issues: the preamble and first portion of the amended claims does not agree with the final result, i.e. preamble and steps a-d of claim 1, and preamble and steps a-e of claim 15, recite methods for obtaining a transgenic maize plant, but the remaining method steps, including the final method step, do not recite that maize plants, maize seeds, or maize progeny are obtained. All claims should be amended to insert the word ---maize--- before each recitation of "seed", "plant", etc. Another 112 second paragraph issue is raised in claims 8, 11-13, and 19-22, for failing to recite that the transgenic plants are maize plants, and for failing to make clear that the transgenic maize plant comprises said sorghum genomic DNA. Another 112 second paragraph issue is raised in claim 15, where "said DNA fragments" in step b lacks antecedent basis in the amended claim; the same problem exists in claim 16. Claims 5 and 18 are further indefinite in their recitation of "recipient plant species" which lacks antecedent basis in amended claims 1 and 15.

Additional New issues: 112 first paragraph new matter issues as discussed below.

b) New matter: There is no basis for "genomic DNA greater than 10kb" as recited in claims 1 and 15 of the amendment of 22 February 2005, or for "genomic DNA greater than 5 kb" as recited in claims 1 and 15 of the amendment of 23 February 2005. The specification provides the following size ranges of DNA: "20 kb to 500 kb" (page 7, line 22; "average size of 150 kb" (page 8, lines 3 and 10; page 14, lines 23-24); and "around 20 kb" (page 9, line 25). However, there is no literal or figurative support for the

Art Unit: 1638

newly claimed ranges. Also, the Wilson declaration of 20 February 2001 refers to "9 kb" (page 3, line 2), but there is no support in the specification for this figure.

c) Failure to simplify: The Wilson declaration of 22 February 2005 is deficient for the reasons stated below, so that the utility and enablement rejections are not overcome.

Item 4. NON-COMPLIANT AMENDMENTS

Neither the amendments of 22 February 2005 nor 23 February 2005 reflect the amendments to claims 4, 6 and 17-18 that were made on 07 January 2002.

Item 10. AFFIDAVIT

The Wilson affidavit of 22 February 2005 is deficient because it is unclear what is meant by "the transformed regenerants of Stine inbred 963" on page 2 of the declaration. As stated above, the specification and declaration of 20 February 2001 recite numerous transformants containing numerous sorghum genomic DNA fragments of different lengths. It is unclear which of these plants were the subject of the photographs mentioned in the Wilson affidavit of 22 February 2005. If these plants do not correspond to any of the previously obtained transformants, then the declaration is deficient for not describing how they were obtained, and which sorghum DNA fragments they contain. Furthermore, copies of the photographs were not be submitted.

Item 11. REQUEST FOR RECONSIDERATION

The Request for Reconsideration relies upon the entry of the amendments of 22 February 2005 and 23 February 2005, but these amendments were not entered.

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180 1638

